

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as “Invention I”, deemed drawn to a method to assess the impact of future changes, and corresponding to claims 1-9. Additionally, Applicant elects, with traverse, what the Examiner has characterized as “Species 2”, deemed drawn to developing an action plan configured to either one of minimizing or eliminating an effect of an impacting change factor, claims 1, and 3-9 being readable thereon.

REMARKS

The Examiner has identified three ‘inventions’ in the pending claims. The Examiner’s classification of the ‘inventions’ include Group I consisting of claims 1-9 drawn to a method to assess the impact of future changes and classified by the Examiner in class 705, subclass 36, Group II consisting of claims 10-15 drawn to a method to address foreseeable change and classified by the Examiner in class 705, subclass 36, and Group III consisting of claims 16-23, drawn to a computer program to determine an effect of a foreseeable event on a present design and classified by the Examiner in class 705, subclass 36.

The Examiner concluded that Groups I and II are distinct because they are “directed to related methods.” *Office Action, Mar. 24, 2006, p. 2* Related inventions may be distinct if (1) the inventions as claimed do not overlap in scope, if (2) the inventions as claimed are not obvious variants, and if (3) “the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.” *MPEP § 806.05(j)*. The Examiner only stated that the inventions are distinct because “the method of group 1 has a different effect.” *Office Action, supra at 2*. However, since the Examiner failed to show distinction under all the elements specifically required in *MPEP § 805.06(j)*, the Examiner’s burden has not been met. Specifically, the Examiner has not shown that the alleged inventions I and II do not overlap in scope and are not obvious variants. As such, the restriction requirement of Groups I and II is improper.

The Examiner also concluded that Groups I and III are distinct because they are “directed to related methods and programs.” *Office Action, supra at 2*. As stated above, related inventions may be distinct if all three of the following criteria are met: (1) the inventions as claimed do not overlap in scope, (2) the inventions as claimed are not obvious variants, and (3) the inventions as claimed can have a materially different effect. *See MPEP § 806.05(j)*. Again, the Examiner only stated that the inventions are allegedly distinct because “the invention of group I has a different

effect.” *Office Action, supra at 3*. That is, the Examiner failed to show distinction under all the elements required in MPEP 805.06(j). As such, the restriction requirement of Groups I and III is improper.

The Examiner also concluded that Groups II and III are distinct because they are “directed to related methods and programs.” *Office Action, supra at 3*. Again, the Examiner only stated that the inventions are distinct because “the invention of group III has a different effect.” *Id.* The Examiner again failed to show distinction under all the elements required in MPEP 805.06(j). As such, the Examiner’s burden has not been met, and the restriction requirement of Groups II and III is improper.

The Examiner further stated that “the inventions require a different field of search.” *See Office Action, supra at 3*. However, the Examiner, “in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.” MPEP § 808.02. The Examiner must show a different field of search by appropriate explanation. *See id.* The Examiner has failed to provide an appropriate explanation. That is, as required under MPEP § 808.02, the Examiner must indicate a pertinent different field of search. As explained above, the Examiner merely stated that the inventions require a different field of search. However, the Examiner classified all three inventions as belonging to the same class and subclass. Since the Examiner believes that all three inventions belong to the same class and subclass, a conclusory statement that a different field of search is required does not, in and of itself, satisfy the Examiner’s burden to show that “it is necessary to search for one of the **> inventions in a manner that is not likely to result in finding art pertinent to the other invention(s)...” MPEP § 808.02. Since all alleged inventions belong to the same class and subclass, Applicant does not believe that a different field of search is required. Accordingly, the Examiner’s burden to appropriately explain a different field of search has not been met.

Additionally, the Examiner required an election of species. As stated above, Species 2 has been elected with traverse. The Examiner’s species restriction requirement is improper.

Specifically, MPEP §806.04(e) states that “[c]laims are definitions of inventions” and that “[c]laims are never species.” Furthermore, “[s]pecies are always the specifically different embodiments.” *See Id. (italics in original, underlining added)*. The Examiner indicated that the species include “(1) periodically evaluating the risk assessment value for each of the number of impacting change factors, (2) developing ab [sic] action plan configured to either one of minimizing or eliminating an effect of an impacting change factor.” *Office Action, supra at 3-4*. However, the Examiner’s alleged species are not specifically different embodiments as required

in MPEP §806.04(e) for species restrictions. As disclosed in paragraph [0026] of the Specification, a design team develops a recommended action plan, which is the design team's plan of attack to minimize or negate the effect of a potential change mode. In addition, paragraph [0028] of the Specification discloses that a new severity value, a new occurrence value, and a new detectability value are determined at periodic intervals or after implementation of the action plan for the identified event and are used to determine a new RPN. Thus, the Examiner's alleged species are not different embodiments as disclosed in the Specification.

Furthermore, it is clear that the Examiner's identification of species is improperly based on claims 2 and 3. For example, claim 2 calls for, in part, periodically evaluating the risk assessment value for each of the number of impacting change factors, which is recited verbatim to the species identified by the Examiner as Species 1. Also, claim 3 calls for, in part, developing an action plan configured to either one of minimizing or eliminating an effect of an impacting change factor, which the Examiner recited as Species 2. Since, as described above, the Specification does not disclose that the alleged species are specifically different embodiment, the only place the Examiner may be getting the species embodiments from is the claims, which is improper under MPEP §806.04(e).

Also, in addition to improper identification of the species and in attempting to show that the species are distinct, the Examiner, as above with regard to the restriction of Groups I, II, and III, merely stated that "the species are distinct because each has a separate effect." *Office Action, supra at 4*. However, a separate effect is not enough to show that species are distinct. Where species are distinct as claimed, "then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP § 806.05 – § 806.05(j)." *MPEP § 806.04(b)*. The Examiner's statement that each species has a separate effect is not enough alone to show distinctness under any of MPEP § 806.05 – § 806.05(j). As stated above, MPEP 806.05(j) may be used to show distinctness where inventions have a materially different effect; however, the Examiner must also show that the inventions as claimed (1) do not overlap in scope and (2) are not obvious variants. As previously discussed, a conclusion that the species are distinct based solely on a different effect is improper. The Examiner has not shown that Species 1 and 2 do not overlap in scope and are not obvious variants. Since the Examiner failed to show distinction under all the elements required in MPEP § 805.06(j), the Examiner's burden has not been met. Therefore, the species restriction requirement is improper.

Since the Examiner failed to address all the elements needed to satisfy the burden to show distinctness either between Groups I, II and III or between Species 1 and 2, the restriction requirement in the Office Action mailed March 24, 2006, is clearly improper and must be withdrawn.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each Group and of each species. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

/Kent L. Baker/

Kent L. Baker
Registration No. 52,584
Phone 262-376-5170
klb@zpspatents.com

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P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170